PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
J. Brian Windsor, *et al.*

Serial No.: 10/047,251

Filed: January 14, 2002

For: GENETIC AND EPIGENETIC MANIPULATION OF ABC TRANSPORTERS AND ECTO-PHOSPHATASES FOR THE CONFERENCE OF DRUG RESISTANCE AND FOR THE LOSS OF DRUG RESISTANCE IN BIOLOGICAL SYSTEMS AND METHODS FOR THE DETECTION OF ECTO-PHOSPHATASE INHIBITORS

Prior Group Art Unit: 1651

Examiner: Weber, Jon P.

Atty. Dkt. No.: TEXG:003USD1

CERTIFICATE OF MAILING
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA, 23313-1450, on the date below:

October 7, 2004
Date

Robert E. Hanson

PETITION UNDER 37 C.F.R. § 1.144 FOR RECONSIDERATION OF DETERMINATION OF FINALITY OF RESTRICTION REQUIREMENT

MAIL STOP PETITIONS
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 23313-1450

Sir:

This Petition is submitted under 37 C.F.R. §1.144 in view of the Office Action mailed June 7, 2004. The Action made the Restriction Requirement dated March 31, 2004 final, over

Petitioner's traversal. This Petition is timely submitted as it is made after a final restriction requirement and prior to appeal or issuance.

The Commissioner is authorized to deduct any petition fee required by 37 C.F.R. §§ 1.16 to 1.21 from Fulbright & Jaworski Deposit Account No. 50-1212/TEXG:003USD1.

STATUS OF THE PROSECUTION

Claims 20-21 and 25-51 were pending in the case after the entry of the Second Preliminary Amendment dated April 25, 2002. A Restriction Requirement was mailed by the Examiner on March 31, 2004, which subjected the claims to a 20-way restriction (Groups I-XX) based on limitations in the dependent claims specifying different ectophosphatase inhibitors. Applicants elected the Group I claims, claims 20-21, 26, 28-31, 32 and 51, with traverse. In response to a species election requirement, Applicants elected, without traverse, (a) plant cells, (b) *Arabidopsis thaliana* AtPGP-1, and (c) *Pisum sativum* apyrase.

In the Office Action dated June 7, 2004, the traversal was held non-persuasive and made final. This Petition is made in response to this holding.

ARGUMENT

1. The Restriction Requirement Was Not Proper

The Restriction Requirement is not proper because the claims are generically linked by claim 20. The basis asserted by the Examiner for disagreeing was that claim 20 is not a linking claim because "claim 20 is only linking in the sense that it broadly encompasses a conceptualization – decreasing drug resistance by inhibiting ectophosphatase." It was further alleged that the claim is not linking because the target organism is only broadly defined and the nature of the inhibitor is not specified with any particularity because there is no common core of compounds. However, the problem with the argument regarding target organisms is that a

species election has already been made with respect to plant cells. With respect to remaining arguments, the position of the Examiner essentially amounts to an objection to generic claims *per se*, which is impermissible under the rules.

What the Examiner attempts to do is foreclose Applicants from claming the invention as they choose to do – in generic format. The limitations that the Examiner seeks to divide the claims into are all found in the dependent claims. However, Applicants are entitled to claim the full breadth of subject matter of the claims as written and thus the Examiner must examine the current claims.

Current claim 20 reads as follows:

> 20. (Currently amended) A method for decreasing drug resistance in a target plant cell comprising introducing to the cell a drug resistance-inhibiting amount of an ecto-phosphatase inhibitory molecule.

This is a proper generic linking claim. A generic claim is a claim that "should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species." MPEP § 806.04(d). In the instant case, the limitations making up the restricted groupings are all found in claims dependent upon claim 20 which specify the particular ectophosphatase inhibitor. All that is necessary under the method of claim 20 is that any ectophosphatase inhibitor be used. As the dependent claims include all of the limitations of claim 20, they must be examined as written, even if it is incorrectly assumed, *arguendo*, that the claims could otherwise be restricted. MPEP § 809.

In a restriction requirement, generic or other linking claims should not be associated with any one of the linked inventions, and this fact should be clearly stated. MPEP §814. This is because such claims must be examined with any one of the linked inventions that may be elected. The current invention is linked by generic claim 20. However, the Examiner refused in the Restriction

Requirement to segregate the linking claims or state on the record that such linking claims are present. Applicants therefore respectfully petition for such action.

With respect to the imposition of the Restriction Requirement as to particular ectophosphatase inhibitors embraced by the generic and linking claims, Petitioners respectfully draw attention to a decision by the Court of Appeals for the Federal Circuit, which notes that an applicant may prosecute generic, linking claims "without running afoul of the restriction requirement ***because they are linking claims***." *In re Michael P. Doyle*, 293 F.3d 1355, 1360 (Fed. Cir., 2002), *citing* MPEP §809.03 (8th ed. 2001) (emphasis added). Indeed, the Court held that the failure to present generic claims in the original prosecution of an application was an error correctable by broadening reissue. *Id.* at 1361-1362. Further, the Federal Circuit noted that allowance of a linking claim prompts the examination of covered claims, stating that "The MPEP expressly provides that '[I]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.'" *Id.* at 1362., *citing* MPEP § 809.04 (emphasis added by the Court).

In the present case, the Restriction Requirement imposed upon the claims with respect to a single species of ectophosphatase inhibitor attempts to foreclose Petitioners' ability to have their generic linking claim properly examined. This is in contradiction to the Federal Circuit's holding in *Doyle* and the procedures set forth in the MPEP and is therefore in error. Applicants therefore respectfully petition to have claim 20 identified on the record as a generic linking claim and to have the claims examined as such.

2. The Examiner Has Failed to State a Basis for the Restriction Requirement

Under 35 U.S.C. §132, whenever the Office makes a requirement, "the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement..."

Further, under the Administrative Procedure Act, an examiner must point to concrete evidence on the record in support of a decision or rejection.[1] Such findings must be supported by "substantial evidence" within the record pursuant to the APA. *See In re Gartside*, 203 F.3d 1305, 1314-15 (Fed. Cir. 2000). This is similarly reflected in the MPEP, which states that the particular reasons for a restriction should be concisely stated and that "a mere statement of conclusion is inadequate." MPEP § 816. Here, however, a statement of conclusions is all that has been provided. No basis in fact has been provided for the propriety of the restriction.

In the Restriction Requirement, it is merely concluded that claim 20 is not a linking claim because elements such as the nature of the inhibitor are not specified with particularity. It is thus asserted that "[o]ne could just as easily write a 'linking claim' as 'organic compounds comprising sulfur that smell badly.'" However, a basis in law or the MPEP for such an allegation is completely missing. The problem the Examiner sees with the claim appears to arise from the fact that it is generic in certain aspects, which is of course the essence of a generic linking claim. Why even the limitation used as an example of what would be an improper linking claim and not permitted is not described. This is not surprising, because a prohibition against any given format of linking claim is not found in the relevant laws.

The failure to set forth a basis for the conclusions made is improper under the statutory mandate and the procedures set forth in the MPEP. As explained above, the conclusions drawn were incorrect, as well as being unsupported. For this additional reason, Applicants respectfully petition for removal of the Restriction Requirement imposed by the Examiner.

3. The Restriction Requirement is not Permitted Under M.P.E.P. §803

M.P.E.P. §803 states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner ***must*** examine it on the merits, even though it

[1] *In re Zurko,* 59 USPQ 2d 1693 (Fed. Cir. 2001).

includes claims to independent or distinct inventions." (emphasis added). Here, a search and examination of all of the current claims would not cause a serious burden to the examiner because the limitations forming the basis for the Restriction Requirement are all found in claims dependent upon claim 20. Specifically, all of the claims incorporate the limitations of claim 20. Therefore, once this claim is searched and found allowable, there is ***no*** additional burden in searching the remaining claims because they are by definition novel and non-obvious upon a finding that claim 20 is free of the prior art. 37 C.F.R. §1.75(c). All of the claims can therefore be examined together with claim 20 without any additional burden.

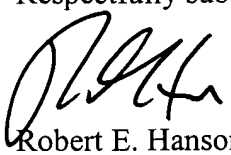
The relevant standard in the M.P.E.P. requires a ***serious*** burden on the examiner in order to support a proper restriction. The relation among the pending claims here eliminates any such serious burden. Maintaining the restriction of these claims would therefore place an unreasonable economic burden on Applicants not justified by the relevant standards. Removal of the restriction is therefore respectfully requested.

In view of the foregoing, Petitions respectfully request removal of the Restriction Requirement.

CONCLUSION

Petitioners respectfully request favorable consideration of this case in view of the above. Should the Office have any questions, comments, or suggestions relating to this case, a telephone call to the undersigned Petitioners' representative at (512)536-3085 is earnestly solicited.

Respectfully submitted,



Robert E. Hanson
Reg. No. 42,628
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512) 474-5201

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